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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/851,639	05/09/2001	William E. Adams IV	010629	3602

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EXAMINER

SZUMNY, JONATHON A

ART UNIT	PAPER NUMBER
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3632

DATE MAILED: 02/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/851,639

Applicant(s)

ADAMS, WILLIAM E.

Examiner

Jon A Szumny

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-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \*   c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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This is the second office action for application number 09/851,639, Suction Holder for Razor, filed on May 9, 2001.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter that the applicant regards as his invention.

Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 11, it appears the "flag" has been doubly included in lines 1 and 4.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claim 11 is rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent number 5,961,087 to Lee.

Lee '087 discloses a holder and flag (figure 2) comprising a suction cup (10) having cup and neck portions (figure 1), wherein the neck has a transverse bore (figure

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2) having a multi-sided cross section, and a flag (101) having a display portion attached to a pole (figure 1), a portion of the pole having a multi-sided cross section complementary to that of the bore and fitted within the bore so it can be rotated therein so that in each position every side of the portion of the pole is opposite a side of the bore.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent number Des. 388,271 to Moore in view of U.S. Patent number 5,323,996 to Rendall, and further in view of U.S. Patent number 5,313,734 to Roberts.

Regarding claims 1 and 6, Moore '271 discloses a holder (figure 1) including an attachment device (figure 1) having a neck (figure 1) containing at least one bore (figure 1), and a ring (figure 1) whereby the ring is rotated within the bore. However, Moore '271 fails to specifically teach the attachment device to be a suction cup or the ring to be a split ring with two ends each fitted within the bore.

Rendall '996 reveals a holder (figure 7) comprising a suction cup (103) having a neck with a bore, and a split ring having two ends each fitted within the bore. It would have been obvious to one of ordinary skill in the art at the time the invention was made

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to replace the attachment device of Moore '271 with the suction cup of Rendall '996 so as to provide an operator with a quickly attachable/detachable but sturdy attachment means. Further, it would have been obvious to replace the ring of Moore '271 with the split ring of Rendall '996 so as to allow for quick disengagement of the ring from the attachment device without having to detach an object being held on the ring from the ring, in addition to reducing materials costs.

Moore '271 in view of Rendall '996 divulge the previously described invention failing to specifically teach the cross sections of the bore and two ends of the split ring to be multi-sided complementary cross-sections. However, Roberts '734 reveals a holder (figure 1) having an end with a multi-sided cross section (38) being fitted with a bore with a complementary multi-sided cross-section (46). It would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the circular cross-sections of the bore and two ends of the ring of Moore '271 in view of Rendall '996 with multi-sided cross-sections as in Roberts '734 so as to allow an operator to effectively position the ring at a desired position while preventing pivoting of the ring to another position.

With respect to claims 2-4, Moore '271 in view of Rendall '996, and further in view of Roberts '734 divulge the previous invention failing to specifically teach the cross-sections to be square, hexagonal or octagonal. It would have been obvious to one of ordinary skill in the art at the time the invention was made that the cross-sections of the bore and the ends of the split ring could be constructed to be any of a number of

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different shapes, including square, hexagonal and octagonal, so long as the ring does not inadvertently pivot from a desired position.

Regarding claim 7, Moore '271 in view of Rendall '996, and further in view of Roberts '734 divulge the previous invention failing to specifically teach the at least one bore to be a pair of bores on a common axis being separated by a web. However, Rendall '996 teaches the previously described holder (figure 7), having a pair of bores (123) on a common axis being separated by a web. It would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the at least one bore of Moore '271 in view of Rendall '996, and further in view of Roberts '734 with a pair of bores on a common axis being separated by a web as in Rendall '996 so as to provide a stopping point for the ends of the split ring so as not to induce excess stress upon the ring which could lead to failure of the ring.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Moore '271 in view of Rendall '996, and further in view of Roberts '734, and further in view of U.S. Patent number 6,131,865 to Adams.

Moore '271 in view of Rendall '996, and further in view of Roberts '734 divulge the previous invention failing to specifically teach the suction cup to be made of soft vinyl or the ring to comprise polypropylene or polycarbonate. However, Adams '865 teaches a holder having a soft vinyl suction cup (column 4, lines 10-11) and a polycarbonate ring (column 3, lines 64-65). It would have been obvious to one of ordinary skill in the art at the time the invention was made to manufacture the suction cup and ring of Moore '271 in view of Rendall '996, and further in view of Roberts '734

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of soft vinyl and polycarbonate, respectively, as in Adams '865 so as to provide for improved gripping strength of the suction cup, and to provide for a resilient but sturdy ring.

Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent number 5,078,356 to Adams in view of Lee '087.

Adams '356 discloses a holder (figure 3) comprising a suction cup (26) having cup and neck portions, the neck containing a transverse bore, and a J-hook (18) having two ends, a portion thereof, having a head adjacent thereof, being fitted within the bore so that the hook can be rotated within the bore from a first position to a second position such that in each position every side of the portion of the hook is opposite a side of the bore.

However, Adams '356 fails to specifically teach the cross sections of the bore and the portion of the hooked fitted within the bore to be complementary multi-sided cross sections. Lee '087 divulges the previously described bore and portion having multi-sided cross-sections. It would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the cross sections of the bore and portion of Adams '356 with the multi-sided cross sections of Lee '087 in order to allow a user to effectively position the hook at a desired position while preventing accidental pivoting of the hook.

***Response to Arguments***

Applicant's arguments filed May 9, 2001 have been fully considered but they are not persuasive.

Regarding the rejection of claim 11 under 35 U.S.C. 112-2<sup>nd</sup> paragraph, the applicant discusses the "holder and flag device being claimed" in line 1. However, a "holder and flag device" is not claimed in line 1 of claim 11. A "holder" and a "flag" are claimed in line 1 of claim 11. For instance, if line 1 of claim 11 is changed to read --A holder and flag device comprising--, the rejection of claim 11 under 35 U.S.C. 112-2<sup>nd</sup> paragraph would be overcome.

On page 5 of the remarks in the paragraph beginning "The Examiner identified", the applicant alleges that the Examiner identified "elements 20, 60, 70 and 80 as the neck portion and element 100 as the pole". This is not true. Regarding the neck portion, the Examiner indicated the general area interpreted to be the neck portion, but not element "80" in particular. With respect to the pole, the Examiner clearly pointed away from element 100 (previous attachment of figure 1) and in the general direction of elements "90" and "80". More specifically, as seen in figure 2, the Examiner interpreted the bore to be as previously indicated, so an ordinary artisan would clearly recognize that the Examiner intended for the pole to be as indicated on the previously attached copy of figure 1, in the general direction of "90" and "80" so that it could be received in the bore, and not element "100".

Regarding the applicant's allegations on pages 5 and 6 that the Lee device does teach the flagpole to have a multi-sided cross-section complementary to that of the



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bore, the Examiner disagrees. As shown in figure 4 of Lee '087, "at least a portion of the pole" (from claim 11) does in fact have a cross section complementary (the balls 88 fill in the grooves 71) to that of the bore. Further, the applicant contends that the bore is not transverse to the neck but axial. The Examiner disagrees. As defined in "Merriam-Websters Collegiate Dictionary, 10<sup>th</sup> Edition", "transverse" is defined as "lying or being across", and "across" is defined as "from one side to the other side", so the bore as indicated by the Examiner is in fact "transverse" to the neck.

On the top of page 7 of the remarks, the applicant claims, "The pole in Roberts can only be rotated after being withdrawn from the bore". This is not true. Lines 54-56 of column 2 of Roberts '734 state that the post is prevented from being totally removed from the mount. Therefore, every side of the end of the split ring (or hook or flagpole) is in fact opposite a side of the at least one bore.

Continuing, in response to the Examiner's assertion that it would be obvious to construct the ends of the split ring "of a number of different shapes...", the applicant alleges "To reach such a conclusion without any support in the prior art is highly improper." The Examiner clearly did not "reach such a conclusion without any support in the prior art". The Examiner introduced the teaching of a multi-sided cross section via the invention of Roberts '734, and an ordinary artisan would recognize that no unexpected results would occur from the use of numerous other multi-sided cross sections such as square, hexagonal or octagonal. The point of the multi-sided cross section is to prevent the ring/post/pole from inadvertently pivoting from a desired position in its respective bore, as is clearly taught by Roberts '734.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

On page 8 of the remarks, the applicant discusses the "complicated" nature of the invention of Lee '087 and how the invention of Roberts' 734 is nonanalogous art. Nevertheless, Lee '087 still does teach a suction cup, neck, pole and bore as required by claim 11.

In response to applicant's argument that Roberts '734 is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, both Roberts '734 and the present invention concern a pole/post rotating in a bore for mounting an object thereon.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jon A Szumny whose telephone number is (703) 306-3403. The examiner can normally be reached on Monday-Friday 8-4.

The fax phone number for the organization where this application or proceeding are assigned is (703) 305-7687.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.



Jon Szumny  
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February 23, 2002



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